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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,971	01/25/2002	Larry Blake	TEKIA.004A	3885

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KNOBBE MARTENS OLSON & BEAR LLP  
2040 MAIN STREET  
FOURTEENTH FLOOR  
IRVINE, CA 92614

EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/14/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/056,971

Applicant(s)

BLAKE ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-221 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-221 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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The Applicant's remarks in regard to the extension fees have been reviewed. The examiner does not believe that the Response received on August 1, 2003, can be considered a "*bona fide* attempt", especially since the Applicant was alerted to the very same type of deficiency in the Office Letter mailed on July 16, 2003. However, if the Applicant wishes to pursue the matter, it is recommended that the Applicant file a separate paper entitled "Letter to the Group Director" with an explanation of the situation.

The following is, in part, necessary in order to correct errors made in the Office action mailed on April 7, 2003. In particular, claims 1 and 39, both of which are directed to an intraocular lens, will be withdrawn from examination if the Applicant again elects (method) Invention III, regardless of the species elected. Also, claim 129 is drawn to a method rather than to a haptic. (In view of the circumstances, the Applicant is permitted to elect an invention and a species different from that elected during the telephone conversation on March 13, 2003, if desired.)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-74, 220, and 221 drawn to an intraocular lens, classified in class 623, subclass 6.46.
- II. Claims 105-128 and 148-219, drawn to a haptic for an intraocular lens, classified in class 623, subclass 4.1.
- III. Claims 75-104, drawn to a method for introducing an intraocular lens into an eye, classified in class 606, subclass 107.
- IV. Claims 129-147, drawn to a method of inserting a haptic into an eye, classified in class 623, subclass 6.12.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, product as claimed can be used in a materially different process. For example, instead of the separate insertion steps of the method, the IOL as claimed can be pre-assembled (the optic and haptic already being attached to one another) and then rolled up into an insertion tube for implantation.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process such as rolling the overall haptic rather than bending or flexing the arms onto or next to or over or toward each other.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the interior angle range (claim 105), the specific type of flexibility (claim 148), or the alignment of V-shaped elements (claim 172 or

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196). The subcombination has separate utility such as supporting a capsular bag and/or preventing cell migration along the capsular bag and/or holding microelectronic components or drug delivery implants or devices other than optics.

Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the bending or flexing step. The subcombination has separate utility such as inserting the haptic for the alternative uses identified above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent required searches, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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**In the event that Invention I or Invention III is elected, the following further requirement is made:**

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I:                      Figure 2;

Species II:                     Figure 3A;

Species III:                    Figure 3B;

Species IV:                    Figure 3C.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species (MPEP § 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**In the event that Invention II or Invention IV is elected, the following further requirement is made:**

This application contains claims directed to the following patentably distinct species of the claimed invention:

**Haptic Cleat**

Species Ia: Figure 3D;

Species Ib: Figure 3E;

Species Ic: Figure 3F.

**Haptic Form**

Species IIa: Figures 2, 5, and 13A-13C;

Species IIb: Figure 4;

Species IIc: Figure 6;

Species IId: Figures 15A and 16C;

Species IIe: Figure 15B;

Species IIf: Figure 15C;

Species IIg: Figure 16B.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, **one each from the above two groupings**, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, **and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species (MPEP § 809.02(a)).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



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A handwritten signature in black ink, appearing to read 'Dave Willse', with a stylized, cursive script.

**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**